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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,537	10/16/2003	Hyun-kwon Chung	1793.1075	4036

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EXAMINER	
PRICE, NATHAN E	

ART UNIT	PAPER NUMBER
2194	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/686,537	CHUNG ET AL.	
	Examiner	Art Unit	
	Nathan Price	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 March 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 October 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to communications received 09 March 2007. Claims 1 – 7 are pending. Previous objections and rejections not included in this Office Action are withdrawn.

Response to Arguments

2. Regarding the first double patenting rejection, the previous Office Action and Applicant's response to the previous Office Action both incorrectly identify the relevant copending application. The correct application number is 10/685,694.

3. Applicant's arguments regarding double patenting rejections have been fully considered. See current rejections.

4. Regarding Lamkin, the application was filed as a continuation.

5. Applicant's arguments regarding rejections under 35 U.S.C. 103(a) have been fully considered but they are not persuasive.

6. With respect to the claimed markup document, Landsman teaches supplying advertisements as HTML files [col. 5 lines 53 – 55; col. 7 line 29; col. 9 line 24].

Landsman teaches a different way of delivering and presenting the advertisements than the identified prior art, but it appears that HTML is an obvious format to use.

7. With respect to the claimed interactive mode, Landsman teaches the advertisements are presented based on a user's actions [col. 10 lines 17 – 20].

8. With respect to the claimed control information, Landsman teaches the advertisements are presented in response to a trigger if the files are fully cached (state is fully cached) [col. 26 lines 43 – 49; col. 35 lines 11 – 12]. Landsman also teaches providing information about downloading operations [col. 35 lines 3 – 6].

9. With respect to the API of claim 3, see the response above. Regarding the parameters, Landsman teaches identifying advertisements by file name (attribute) and web address [col. 12 lines 24 – 26].

Priority

10. Examiner acknowledges that an English translation of a foreign application has been submitted.

Drawings

11. The drawings are objected to because Figures 1, 2 and 12 fail to conform to 37 CFR 1.84(p)(1) and 37 CFR 1.84(q) and Figures 2 and 12 fail to conform to 37 CFR

1.84(p)(3). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/685,694. Although the conflicting claims are not identical, they are not patentably distinct from each other because the apparatus, which includes a buffer, of claim 1 of the copending application anticipates the data storage medium of claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/685,696. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the copending application anticipates the data storage medium of claim 1. Although it is not specifically recited in claim 1 of the copending application, the information must be stored if a program can output it.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 10/685,697. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 17 of the copending application anticipates the data storage medium of claim 1. See the rejection involving copending Application No. 10/685,696 above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 10/685,699. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 9 of the copending application anticipates the data storage medium of claim 1. See the rejection involving copending Application No. 10/685,696 above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/686,521. Although the conflicting claims are not identical, they are not patentably

distinct from each other because claim 1 of the copending application anticipates the data storage medium of claim 1. See the rejection involving copending Applications 10/685,694 and 10/685,696 above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

17. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The data storage medium appears to store only nonfunctional descriptive material. See MPEP 2106.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

18. Claims 1 – 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Lamkin et al. (US 2005/0278729 A1; hereinafter Lamkin). Claims in Lamkin teach claims 1 – 7.

Claim 1 is taught by claim 1 of Lamkin.

Claim 2 is taught by claims 1 – 3 of Lamkin.

Claim 3 is taught by claims 1 and 7 of Lamkin.

Claim 4 is taught by claims 1 and 5 of Lamkin.

Claim 5 is taught by claims 25 and 27 – 29 of Lamkin.

Claim 6 is taught by claims 25 and 27 – 30 of Lamkin.

Claim 7 is taught by claims 1 – 4 of Lamkin.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. Claims 1 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al. (US 6,466,967 B2; hereinafter Landsman) in view of Silberschatz (Silberschatz, Avi, Peter Galvin and Greg Gagne, "Applied Operating System Concepts," First Edition, John Wiley & Sons, Inc., 2000.).

20. As to claim 1, Landsman teaches a data storage medium, comprising:

AV data [col. 25 lines 33 – 38; col. 26 lines 1 – 15];

a markup document which is provided to reproduce the AV data in an interactive mode [col. 9 lines 23 – 55; col. 10 lines 5 – 31; col. 26 lines 43 – 49]; and

control information, which is provided to identify buffering state information of the markup document to be downloaded [col. 34 line 66 – col. 35 line 18].

21. Landsman fails to specifically state that buffering state information is identified by control information. However, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to include control information which is provided to identify buffering state information of the markup document to be preloaded because Landsman teaches that the advertisement can not be played until after it is cached [col. 26 lines 43 – 49], motivating one of ordinary skill in the art to provide a way to determine if it is cached. Furthermore, Silberschatz teaches outputting state information of a buffer [page 427 # 6 – 8].

22. It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine these teachings because Landsman teaches performing I/O in a computer system and Silberschatz teaches the details of servicing I/O requests.

23. As to claim 2, Landsman teaches the control information includes an API that generates a report signal used to identify a buffering state of the markup document [col. 34 line 66 – col. 35 line 18]. See the rejection of claim 1 for further explanation.

24. As to claim 3, Landsman teaches the control information includes an [obj].isCached(URL, resType) API that generates a report signal, where the URL is a parameter indicating a file path of the markup document and the resType is a parameter indicating an attribute of the markup document [col. 12 lines 15 – 38; col. 26 lines 43 – 49; col. 34 line 66 – col. 35 line 18]. See the rejection of claim 1 for further explanation.

25. As to claim 4, Landsman fails to specifically teach returning a value based on success, failure or incomplete loading. However, Silberschatz teaches returning values depending on the current state, including success, failure and incomplete [page 422 ¶ 3; page 427 # 6 – 8].

26. As to claim 5, Landsman teaches the control information includes an API that generates a fetch signal used to issue a command to preload the markup document [col. 34 line 66 – col. 35 line 18]. See the rejection of claim 1 for further explanation.

27. As to claim 6, Landsman teaches or at least implies that the API returns a response indicating whether the command to preload the markup document has been successfully transmitted using the fetch signal [col. 34 line 66 – col. 35 line 18].

Landsman teaches providing information and control over downloading, such as providing an indication that downloading is being performed or complete, which would indicate a request was successfully transmitted. This would be important because Landsman teaches that advertisements can only play after being fully cached [col. 26 lines 43 – 49].

28. As to claim 7, Landsman teaches the control information includes an API that is used to determine whether preloading of the markup document is completed [col. 34 line 66 – col. 35 line 18]. See the rejection of claim 1 for further explanation.

Conclusion

29. The prior art made of record on the P.T.O. 892 that has not been relied upon is considered pertinent to applicant's disclosure. Careful consideration of the cited art is required prior to responding to this Office Action, see 37 C.F.R. 1.111(c).

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Price whose telephone number is (571) 272-4196. The examiner can normally be reached on 6:30am - 3:00pm, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Thomson can be reached on (571) 272-3718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NP

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